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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,963	12/27/2001	Mark D. Velligan	554912000200	7363
38706	7590	11/19/2004	EXAMINER	
FOLEY & LARDNER LLP THREE PALO ALTO SQUARE 3000 EL CAMINO REAL SUITE 100 PALO ALTO, CA 94306			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 11/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/026,963

**Applicant(s)**

VELLIGAN ET AL.

**Examiner**

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 09/09/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-14,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1,3,4,6-14,20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. This application claims benefit of the provisional application: 60/258,842 with a filing date 12/27/2000.
2. Amendment of claims 1, 3, 10, and 12, and cancellation of claims 2, 5, 15-19, and 22 in the amendment filed on September 09, 2004, is acknowledged. Claims 1, 3-4, 6-14, and 20-21 are pending in the application.

### ***Responses to Election/Restriction***

3. Applicant's election with traverse of Group I claims 1, 3-4, 6-14, and 20-21, in part, in the reply filed on September 09, 2004, is acknowledged. The traversal is on the grounds that the restriction requirement is improper because the instant compounds of formula (I) of Groups I-V share a common utility and have a common nucleus, and MPEP 803.02 is cited. This is not found persuasive, and the reasons are given, *infra*.

### ***Status of the Claims***

4. Claims 1, 3-4, 6-14, and 20-21 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (I), wherein the variable R is as defined in claim 1; the variables R<sup>1</sup> and R<sup>2</sup> independently represents hydrogen, alkyl, or -COR<sup>3</sup>, wherein R<sup>3</sup> does not represent heteroaryl, substituted heteroaryl, or heterocycle, and variables R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> independently are not substituted with heteroaryl, substituted

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heteroaryl, or heterocycle, except the heteroaryl or heterocycle of  $R^3$  of  $-COR^3$  represents pyrrolidine thereof; the variable L does not represent heteroaryl, substituted heteroaryl, or heterocycle, the variable L is not substituted with heteroaryl, substituted heteroaryl, or heterocycle thereof; the variables m and n represent 0 or 1 thereof.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups (i.e., heteroaryl, heterocycle, heteroarylene, heteroaralkyl having heteroaryl) which differ from those of the elected invention such as piperazine, morpholine, pyridazine, pyrimidine, etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e., class 544 subclass 358(+) (piperazine), class 544 subclass 106(+) (morpholine), class 544 subclass 224 (+) (pyridazine), class 544 subclass 242 (+) (pyrimidine), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly.

The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these

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inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually.

Additionally, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

The invention claims 1, 3-4, 6-14, and 20-21, in part, embraced in above elected subject matter are prosecuted in the case. Claims 1-17, 21-23, and 25-30, in part, not embraced in above elected subject matter, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Objection***

5. Claims 1, 3-4, 6-14, and 20-21 are objected to as containing non-elected subject matter, i.e., heteroaryl, heterocyclic, heteroarylene, heteroaralkyl having heteroaryl, heteroarylthioalkyl, the variables m and n represent 2-4, pyrimidine, imidazol, quinoline, piperazine, the third compound of claim 21, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the elected subject matter of pages 2-3, *supra*.

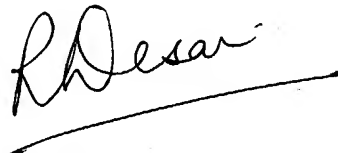
### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rita Desai  
Primary Patent Examiner  
Technical Center 1600  
Tel: (571) 272-0684



Robert Shiao, Ph.D.  
Patent Examiner  
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11/10/04

November 10, 2004